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| 10/648,332      | 08/27/2003  | Wing Chung Joseph Lau | 016660-167          | 5340             |

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| EXAMINER |
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DEXTER, CLARK F

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| ART UNIT | PAPER NUMBER |
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3724

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/648,332

Applicant(s)

LAU ET AL.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II (claims 1 and 3-7) in the reply filed on June 21, 2005 is acknowledged. The traversal is on the ground(s) that (1) all of the claims depend from a single dependent claim and thus are based on a single inventive concept; (2) the Office action does not provide proper support for the claim groupings; and (3) the Office action has not shown that a serious burden would be imposed on the Examiner by examining all of the claims. This is not found persuasive for the following reasons.

Regarding (1), the Examiner has acknowledged that all of the dependent claims depend from a single independent claim. Further, the Examiner has stated that if the independent claim is determined to be allowable (i.e., a single inventive concept), the withdrawn claims that are dependent therefrom would be rejoined. However, it has been determined that the independent claim is not allowable. Therefore, the restriction cannot be withdrawn on this basis.

Regarding (2), the examples of separate classification were cited to demonstrate the divergent searches required for each group. Separate consideration and search is required for the subject matter in each group. More specifically, the search for the type of locking configuration of Group II clearly requires a separate search and consideration of separate prior art issues than those required to determine patentability based on the

specific housing configuration and patentability based on the specific type of material.

Thus the Examiner maintains that the basis for restriction is proper.

Regarding (3), as described above for point (2), separate consideration and search is required for the subject matter in each group, including the development of separate text searches. Such separate consideration and search clearly places a serious burden on the Examiner to consider all of the claims during the examination of a single application. Thus, for at least these reasons, the Examiner maintains that the basis restriction is proper.

Claims 2 and 8-10 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

2. The drawings are objected to because of the following informalities:

In Figure 1, numeral 39, which is described but not shown, should be added for clarity.

In Figure 8, numerals 12, 14, 16, 18, 20, 24, 30 and 38 should be added for clarity.

In Figure 9, the lead line for numeral 36 is inaccurate and should indicate the engaging means; numeral 34 should be added for clarity.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Abstract***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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4. The abstract of the disclosure is objected to because the use of "means" in line 8 and the use of "said" in line 9 is improper. Correction is required. See MPEP § 608.01(b).

### ***Specification***

5. The disclosure is objected to because of the following informalities:

On page 4, line 25, the description "is connected at its lower end to the stage 12" is unclear since it is not clear how the wall 22, which is static, can be connected to the stage 12 which is movable.

Page 7, line 1, "of" is unclear, and it seems that it should be changed to --that are-- or the like.

Appropriate correction is required.

### ***Claim Objections***

6. Claims 1 and 3-7 are objected to because of the following informalities:

In claim 1, line 3, the recitation "its cutting blade" appears to be improper since it may be considered to lack positive antecedent basis.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Best, pn 4,345,498.

Best discloses a food slicer with almost every structural limitation of the claimed invention including a base portion (e.g., the vertically extending portion such as 12 as shown in Figure 2) and an operable portion (e.g., the portion(s) extending from the vertically extending portion such as 104, 122, 138); and locking means, wherein the locking means comprises at least one bolt (172) that is adapted to be received in a recess (e.g., 174) of an engaging means, wherein the bolt is connected to a switch (e.g., 170), and wherein the bolt is comprised in the base portion and the engaging means comprising the recess is comprised in the operating portion. Best lacks a disclosure as to what material the slicer, excluding its cutting blade, is made;

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specifically, that it is made principally of plastics or polymeric materials. However, the Examiner takes Official notice that making slicers from such materials is old and well known in the art and provides various well known benefits including providing a material that is light weight, easy and inexpensive to manufacture (e.g., by relatively inexpensive molding processes), and is resistant to corrosion. Some examples demonstrating that making slicers from such materials is known are Fuse, pn 4,246,821 (e.g., see col. 3, line 19); Lorenz, pn 4,070,941 (e.g., see col. 2, line 29); and Artin et al., pn 4,273,013 (e.g., see col. 1, line 30). Therefore, it would have been obvious to one having ordinary skill in the art to make the slicer, excluding its cutting blade, principally of plastics or polymeric materials for the well known benefits including those described above.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571)272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cfd  
September 6, 2005